

Remarks

Applicants' attorney wishes to thank the Examiner for her time during the Interview on June 18, 2009, in which a proposed amendment after final was discussed. No agreement was reached as to allowable subject matter.

The Office Action mailed March 17, 2009, has been carefully considered. After such consideration, independent Claims 1; 12; and 26 have been amended to recite that the area separation wall is rated for two hours fire resistance according to Underwriter Laboratories, Inc. Test ANSI/UL 263 as set forth in the Specification at, for example, page 1, lines 25-30. Thus, Claims 1-3 and 5-11; 12-20 and 22-25; and 26-27, 29-43 and 45-48 remain in the case with none of the claims currently being allowed.

As a preliminary matter, Attachment A in the December 4, 2008 Response (responding to June 6, 2008 Office Action) was submitted in error. Applicants intended to submit "Online Certifications Directory BXUV.U370, Fire Resistance Ratings – ANSI/UL 263", dated **February 26, 2003**, but instead submitted Online Certifications Directory BXUV.U370, Fire Resistance Ratings – ANSI/UL 263", dated **November 6, 2006** (a revised version).

These documents are substantively similar, except for the dates. The former was previously submitted in the Information Disclosure Statement filed March 30, 2004. The latter is an updated version and is not prior art with respect to the February 25, 2004 filing date of the present case.

Also, the proposed draft Amendment faxed to and discussed with the Examiner on June 18, 2009, appears to have been entered into PAIR as a formally submitted amendment. However, as can be seen in Attachment A of this paper, it was clearly marked Draft and PROPOSED and unsigned. Therefore, it was improperly entered as an amendment.

I. Rejection of Claims 1, 12, and 26 Under 35 USC §112, ¶1

Applicants respectfully disagree with the Office's position that "an area separation wall rated for two hours at about 75% design load" lacks antecedent basis in the original specification.

As previously explained, the specification discusses the ANSI/UL 263 test¹, which reports 75% of Design Load at 2 hours.²

Withdrawal of the rejection is respectfully requested. However, to advance prosecution, independent Claims 1; 12; and 26 have been amended to specifically recite this test procedure and to remove the reference to 75% load, which the Examiner had objected to.

II. Rejection of Claims 1-3, 5-20, 22-27, 29-43 and 45-48 Under 35 USC §103(a)

The Office also appears to take the position that area separation walls rated for two hours at about 75% design load are known in the art because the same is disclosed in the “Online Certification Directory BXUV.U370, Fire Resistance Ratings ANSI/UL 263”. However, this reference is not being properly applied because it was neither:

- a) known or used by others before the applicants’ invention; nor
- b) described in a printed publication more than one year prior to the date of the application.

Specifically, the testing reported in the “Online Certification Directory BXUV.U370, Fire Resistance Ratings ANSI/UL 263” report **was commissioned by the assignee** of the application **to be performed on the inventors’ invention**. Accordingly, the “known or used by others” [emphasis added] requirement of 35 USC §102(a) has not been met.

Applicant is also willing to file a 1.131 declaration swearing behind this reference if requested to do so by the Examiner, but does not see any reason that this would be required.

Moreover, the “Online Certification Directory BXUV.U370, Fire Resistance Ratings ANSI/UL 263” does not qualify as a 35 USC §102(b) printed publication because the report is dated **February 26, 2003**, whereas the filing date of the present application is **February 25, 2004**, which is less than one year prior to the filing date of the present application.

In view of the inapplicability of “Online Certification Directory BXUV.U370, Fire Resistance Ratings ANSI/UL 263” as a reference, and the failure of Gebhardt, Mulford, and

¹ See page 1, lines 29-30.

ASTM E119-95a (the “Omega Reference”) to teach area separation walls rated for two hours fire resistance according to Underwriter Laboratories, Inc. Test ANSI/UL 263, the Office has failed to establish *prima facie* obviousness.³ Accordingly, withdrawal of this rejection is respectfully requested.

III. Request for Withdrawal of Final Office Action

In view of “Online Certification Directory BXUV.U370, Fire Resistance Ratings ANSI/UL 263” being improperly applied, Applicants request the finality of the current Office Action be vacated and prosecution reopened.

For at least the reasons discussed above, Applicants believe the Office’s rejections have been addressed and overcome, and earnestly solicit allowance. However, if Applicants’ attorney can assist in resolving any issue, the opportunity for a telephone interview would be welcomed.

Respectfully submitted,



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² See page 2 of “Online Certifications Directory BXUV.U370, Fire Resistance Ratings – ANSI/UL 263”, dated February 26, 2003.

³ As discussed in the Response dated 12/4/08, Gebhardt does not appear to be suited for multi-level structures, and therefore does not inherently or explicitly teach 75% load bearing. Mulford walls are “slid into” building frames and do not appear to provide load bearing properties, let alone 75% load bearing. The Omega Reference does not teach 75% design load, it teaches 47.5% design load. Finally, as set forth in the previously offered Declarations of Stewart and Trumbo, 2 hours at 75% are structurally and commercially critical.